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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,811	09/17/2003	James A. Duggan	1-22818	3457

27210 7590 06/07/2005

MACMILLAN, SOBANSKI & TODD, LLC
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720 WATER STREET
TOLEDO, OH 43604

EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,811

Applicant(s)

DUGGAN ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claims 21 & 23-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claim 21 has been withdrawn because it has been amended to include the limitations of formerly withdrawn claim 22.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the arm portions described in the specification at page 10 which is the structure which makes it possible to vary the position of the discs 22 & 23 relative to each other as recited in claim 11, line 8 and claim 17.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. Claims 11 & 13-20 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The disclosed invention, a balanced assembly, is inoperative because the respective arm portions required to assemble the assembly would impart an imbalance unaccounted for in the assembly. The balance corrective device 20 as shown will only provide corrective balance to the article 15a if the ball 24 is the only variable in the mass distribution of the device 20 (i.e. all other parts (e.g. discs 22 & 23) in the device must have homogenous mass distribution). However, the required arm portions and the slots 22a & 23a, are additional means that vary the mass distribution of the device 20, means whose effects are unaccounted for in the construction of the disclosed invention.

6. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claims are directed to the assembly of claim 11 (which is balanced per claim 11, line 1) in combination with a control system for balancing and unbalanced article.

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Why would a balanced assembly need such a control system? There is no patentable utility for such a combination.

Claim Rejections - 35 USC § 112

7. Claims 11 & 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 11, lines 8 & 9 recites that the claimed invention, an assembly that is balanced for rotation, is made by relatively positioning two discs, but the specification fails to teach how to make such an assembly given that the disclosed invention requires arm portions to relatively position the discs, arm portions that impart imbalance that is unaccounted for in the final assembly.

8. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claims 17-20 is unclear. The limitations of claims 17-20 appear to be written so as to read on the combination of elements shown in Fig. 7 which only shows a step in the construction of a final product (shown in Fig. 1). As such the limitations in claims 17-20 do not all appear to be parts of a final product, the stated claimed invention, a balanced assembly.

Response to Arguments

9. Applicant's arguments filed May 2, 2005 have been fully considered but they are not persuasive:

a. Applicant argues that claims 22-30 should not have been withdrawn at the time of the last Office action because they depended from a linking claim. However, the existence of a linking claim (or dependence thereof) does not constitute grounds for overcoming a restriction requirement.

b. Applicant argues that the drawings do not have to show the structure which positions the discs because the structure is not claimed. However, (1) applicant is required to show all structure that is essential to the proper understanding of the invention; (2) the examiner determines the completeness of the drawings; and (3) the claims do cover (see particularly claims 11 & 17) the structure which is used to position the disks.

c. Applicant argues that the disclosed invention is operable because the claims do not recite the respective arm portions. However, the disclosed invention (see particularly page 10, lines 16+) does include the respective arm portions. The claimed invention, regardless of what is or is not recited, cannot be operable if the disclosed invention is inoperable.

d. Applicant argues that a balanced assembly in combination with a control system for balancing the assembly has patentable utility because the control system balances the balanced assembly. However, a balanced assembly is by definition – balanced. It

therefore has no use for a control system that imparts balance. As such, there is no patentable utility for such a combination.

e. Applicant argues that the claimed invention is enabled because the claims do not recite the respective arm portions. However, the claims must be enabled by the specification, regardless of what is, or is not, recited in the claims.

f. Applicant argues that the scope of claims 17-20 is clear, but cannot, or will not, answer why a balanced assembly would need to be constructed in combination with a control system whose only purpose is for balancing an unbalanced assembly. Claims 17-20 appear only to be an inappropriate attempt to acquire patent protection for a step in the process of making a balanced assembly by claiming an intermediate combination of elements present only temporarily in the process of making said assembly.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kim shows an assembly.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

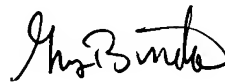
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
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